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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/979,570

11/26/2002

Marvin A. Frenkel

MAF-10002/22

6028

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EXAMINER

AUGUSTIN, EVENS J

ART UNIT

PAPER NUMBER

3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/979,570

Applicant(s)

FRENKEL, MARVIN A.

Examiner

Evans Augustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5,7 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,7 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/10/03</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

***DETAILED ACTION***

1. Request for continued examination under 37 CFR 1.114 s acknowledged.

***Response to Amendment***

2. This is in response to an amendment file on 11/09/2006 for letter for patent filed on 11/14/2001. In the amendment, claims 1, 5 and 7 have been amended. Claims 10 have been added. Claims 2-4, 6, 8 and 9 have been cancelled. Claims 1, 5, 7 and 10 are pending in the letter.

3. With regard to the claimed priority date of PCT, according to the MPEP 1896, section II (Effective Date As A reference):

If a reference resulted from, or claimed the benefit of, an international application, the following must be determined:

(A) If the international application meets the following three conditions:

- (1) an international filing date on or after November 29, 2000;
- (2) designated the United States; and
- (3) published under PCT Article 21(2) in English

Since the PCT application was filed prior to November 29, 2000, (filed on 5/12/2000), the benefit date of PCT will not be granted. The actual filing date of the later-filed U.S. application will be applied for prior art purposes. International applications, which:

- (1) were filed prior to November 29, 2000, or (2) did not designate the U.S., or (3)

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were not published in English under PCT Article 21(2) by WIPO, may not be used to reach back (bridge) to an earlier filing date through a priority or benefit claim for prior art purposes under 35 U.S.C. 102(e) (MPEP 706.02 (a)).

### *Status of Claims*

4. Claims 1, 5, 7 and 10 have been examined.

### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, claim 1 contains a serial number(s), which was randomly generated. According to Microsoft Press Computer Dictionary, random is produced via an unpredictable sequence of numbers in which no number is any more likely to occur at a given time or place in the sequence than any other. Claim 10 states that the randomly generated serial number comprises the user's age. If that is the case the serial number is not randomly generated.

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Claim 10 is also rejected under 35 U.S.C. 101 for the same reason set forth above.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 5, 7 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Keil (U.S 20010023415).

8. In determining patentability of an invention over the prior art, the USPTO has considered all claim limitations. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art.

1. It should also be noted that, in the office action:

- a. Italicized items in parentheses are claim limitations
- b. A/B = A and B are equivalent or synonymous

9. As per claims 1, 5, 7 and 10, Keil discloses an invention that relates to a system and method for establishing a globally accessible debit account via a point of sale (POS) terminal.

The invention comprises of the following:

- Customer provides funds to be deposited with a **merchant/entity/depository** – that is not associated with the customer/**independent** (page 2, par.16, par. 37). The funds include hard currency/**cash**, electronic currency (issued through credit or debit cards), or

negotiable instruments. Personal identification data from the customer is not required to establish the account, and the account holder identity can remain **anonymous** (par. 16) (*a customer depositing cash with a depository, the depository being independent of said customer such that the identity of said customer remains anonymous*) – **Claim 1**

- Conducting financial transactions in the practice of the invention is readily accomplished using existing electronic funds transfer (EFT) (par. 42). Inherently, the hard currency provided by the client would have to be converted in electronic format in order for the EFT to take place (*the depository converting said cash into electronic currency, setting up a numbered account and placing said electronic currency into said numbered account;*) – **Claim 1**
- Customer receiving a debit account number unique to the transaction from the **merchant/entity/depository**; receiving a unique personal identifier number (PIN), (which is anonymous) corresponding to the debit account number from **merchant/entity/depository** (page 2, par.16, par. 37). **The PIN can be randomly generated** (par. 39)(*the depository issuing to the customer one or more anonymous and randomly-generated serial number numbers corresponding to the account number*) – **Claim 1**
- Customer providing an unanimous account number and PIN for paying for transactions that were conducted over the internet. (par. 41) Doing transactions over the internet with a merchant, that merchant would be called **on-line merchant**. The methods and mechanisms by which debit transactions can be performed vis-a-vis electronic funds transfer networks are well-known in the art (par. 42). The identity of the customer is not

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revealed since the customer established an anonymous debit account which can be accessed using the only the debit account number in conjunction with the corresponding PIN (par. 40) *(the customer submitting the at least one serial number to the on-line merchant to purchase goods or services, said on-line merchant and said depository being unable to identify said customer during said purchase and; the depository transferring an amount of said electronic currency corresponding to said at least one serial number to an account of said on-line merchant)* - **Claim 1**

- The fact that customer provides a unanimous account number and PIN for paying for transactions that were conducted over the internet (par. 41), the customer inherently gets authenticated by providing PIN, which get reconciled via a database (par. 18, par. 40) *(transmits said serial number to a server of said depository for authentication)* - **Claim 5**
- The prior includes transaction terminal having input means, display means, and processing means (par. 16) – and during an internet transaction, the PIN has to be presented to the merchant via a form an terminal – **Claim 7**

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keil (U.S. 20010023415), in view of DiMaria et al. (U.S. 6148091).

As per claim 10, Keil's invention has previously been disclosed.

Keil did not explicitly describe a method/system in which serial number/unique identifier comprises information/data about the customer's age. However, DiMaria et al. describes an invention that relates to accessing personalized identification information and encoded age data stored in at least one machine readable medium on an individual's identification document, such as a driver's license or other official document, to determine whether an individual is of legal age. According to DiMaria et al., age data is encoded into a machine readable surface (column 2, lines 61-65). The surface can be anything, printed, written, encoded, etc., which is relied upon to record data or provide identification (column 3, lines 42-45).

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that would employ a method/system in which serial number/unique identifier comprises information/data about the customer's age. According to DiMaria et al. the motivation would be to provide an inexpensive method and apparatus to check age data on a bearer's identification document and to alert an operator as to whether the bearer may purchase or rent age-controlled merchandise or services (column 3, lines 12-15).



### ***Conclusion***

12. *Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Prior art should be considered in its entirety, including disclosures that are not referenced in this office action.*

13. The prior art made of record and not relied upon is considered very pertinent to applicant's disclosure, and the USPTO strongly suggests that applicant to looking into the references below.

- **Kazaks et al. (US 20020046341)** - The invention relates to pre-paid payment cards, virtual or real, in which the identity of the bearer may be real, anonymous, or pseudonymous
- **Low et al. (US 20020016763)** - This invention relates generally to systems and methods for transferring funds and more particularly to systems and methods for electronic transfer of funds between a sender and a recipient
- **Shub et al. (US 6807530)** - he present invention generally relates to techniques for controlling and limiting the flow of identification information in a commercial transaction, and more particularly to a method and apparatus which enables customers

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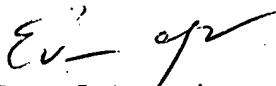
to remotely order goods from a merchant and receive the goods without revealing the customer's identity or address to the merchant


- **Mark (US 20020016763)** - This invention relates generally to systems and methods for transferring funds and more particularly to systems and methods for electronic transfer of funds between a sender and a recipient

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

  
Evens J. Augustin  
January 31, 2007  
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